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Peter Reginald Lewis

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EXAMINER

THOMPSON, MICHAEL M

ART UNIT

PAPER NUMBER

3629

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/500,770	<b>Applicant(s)</b> LEWIS, PETER REGINALD	
	<b>Examiner</b> Michael M. Thompson	<b>Art Unit</b> 3629	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 04 March 2009.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 23-44 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 23-44 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 101***

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. **Claims 23-41 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.**

The first step in determining whether a claim recites patent eligible subject matter is to determine whether the claim falls within one of the four statutory categories of invention recited in 35 USC 101: process, machine, manufacture and composition of matter. The latter three categories define "things" or "products", while a "process" consists of a series of steps or acts to be performed. For purposes of 101, the analysis of a process is guided by the machine-or-transformation test. *In re Bilski*, \_\_\_ F.3d \_\_\_ (Fed. Cir. 2008)(en banc).

Based on Supreme Court precedent (*Diamond v Diehr*, 450 U.S. 175,184 (1981); *Parker v. Flook*, 437 US 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1876)) and recent precedent from the Federal Circuit from *In re Bilski*, the machine-or-transformation test is a two-branched inquiry; an applicant may show that a process claim satisfies § 101 either by showing that his claim is tied to a particular machine, or by showing that his claim transforms an article. See *Benson*, 409 U.S. at 70. Certain considerations are applicable to analysis under either branch. First, as illustrated by *Benson*, the use of a

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specific machine or transformation of an article must impose meaningful limits on the claim's scope to impart patent-eligibility. See *Benson*, 409 U.S. at 71-72. Second, the involvement of the machine or transformation in the claimed process must not merely be insignificant extra-solution activity. See *Flook*, 437 U.S. at 590. If neither of these requirements is met by the claim, the method is not a patent eligible process under 35 U.S.C. 101.

3. **Claims 23-41** are drawn to **a method for managing unit reservation of an account by a credit management system**. All of the recited method steps can be performed by the user themselves, in the mind of the user or between different users through writing by a user, and therefor these method steps are not tied to a particular machine nor do they transform an article. To qualify as a statutory process, the claim should positively recite in the body of the claim, the particular machine to which it is tied. For example, by identifying the particular machine that accomplishes the method steps, or positively reciting the article that is being transformed.

Please note that ***nominal recitations of a machine in an otherwise ineligible method fail to make the method a statutory process***. See *Benson*, 409 U.S. at 70 - 72. As *Comiskey* recognized, "the mere use of the machine to collect data necessary for application of the mental process may not make the claim patentable subject matter." *Comiskey*, 499 F.3d at 1380 (citing *In re Grams*, 888 F.2d 835, 839-40 (Fed. Cir. 1989)). Incidental physical limitations, such as data gathering, field of use limitations, storing, collecting, sending, receiving, and other forms of insignificant extra solution activity are not enough to convert an abstract idea into a statutory process. In

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other words, nominal or token recitations of involvement of a machine or transformation in a method claim do not convert an otherwise ineligible claim into an eligible one. Ex *parte Langemyr* (2008) and *In re Bilski*, (Fed. Cir. 2008).

Therefore, the applicable test to determine whether a claim is drawn to a patent-eligible process under § 101 is the machine-or-transformation test set forth by the Supreme Court and clarified herein, and Applicants' claim here appears to fail this test. *In re Bilski*. No new matter should be added.

### ***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. **Claims 23-44 are rejected under 35 U.S.C. 102(b) as being anticipated by Smith et al. (WO 98/56160).**

6. **With respect to claim 23**, Smith et al teaches a method for managing unit reservation of an account by a credit management system in a multi service telecommunications system, wherein services are provided in exchange for units, wherein a predetermined amount of units (i.e. prepaid amount) is available for the account and which units are reserved before provisioning of a service (i.e. amount withdrawn to cover the cost for a call of typical duration), comprising: a step of forced booking during service provisioning by said credit management system of actually consumed units for at least one service (i.e. either the amount that is "force" booked

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such as the "short call" or it could be interpreted to be the amount that is "force" booked in subsequent allocations). (i.e. abstract, pg 5 lines 11-27, and pg 6-7 lines 12-4.)

7. **With respect to claim 24**, Smith et al teaches the method according to claim 23, wherein said forced booking is carried out if said amount of units drops below a predetermined threshold. (i.e. the amount that is "force" booked such as in the case of a "short call" or similarly if there is a threshold determination similar to page 9, lines 15-27.) (i.e. abstract, pg 5 lines 11-27, and pg 6-7 lines 12-4)

8. **With respect to claim 25**, Smith et al teaches the method according to claim 24, wherein said forced booking is service dependent. (i.e. in this case the booking is service dependent on prepaid accounts associated with the cost of a call. On page 7 lines 2-4 other types of services are indicated.) (i.e. abstract, pg 5 lines 11-27, and pg 6-7 lines 12-4)

9. **With respect to claim 26**, Smith et al teaches the method according to claim 25, wherein in connection with said forced booking a request for accreditation of units can be carried out for said services. (i.e. remaining time is inherently accounted for, abstract, pg 5 lines 11-27, and pg 6-7 lines 12-4) (i.e. interpreted otherwise, the time is "accredited" by different methods as described on pages 8-9 lines 27-9 and as well on pages 10-13.)

10. **With respect to claim 27**, Smith et al teaches the method according to claim 26, wherein accreditation of said units is subject to a plurality of accreditation rules. (i.e. the time is "accredited" by different methods as described on pages 8-9 lines 27-9 and as well on pages 10-13 in the form of rules for accreditation.)

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11. **With respect to claim 28**, Smith et al teaches the method according to claim 27, in which at least one of said accreditation rules is dependent on the actual use of said units per unit of time per service. (i.e. all calculations are related to actual use and are based on time when using the prepaid calling service since determining the calling time that remains is critical. These methods are exemplified by the different methods as described on pages 8-9 lines 27-9 and as well on pages 10-13.

12. **With respect to claim 29**, Smith et al teaches the method according to claim 27, in which at least one of said accreditation rules is dependent on a classification of said services. (i.e. such as the accreditation rules of 27, they are related to the phone billing services, pages 8-9 lines 27-9 and as well on pages 10-13.)

13. **With respect to claim 30**, Smith et al teaches the method according to claim 29, wherein said classification is a prioritization. (i.e. in this case the priority is related to prepaid calling services. On page 7 lines 2-4 other types of services are indicated.)

14. **With respect to claim 31**, Smith et al teaches the method according to claim 27, in which at least one of said accreditation rules is dependent on the amount of units requested. (i.e. accreditation rules inherently rely on the amount of units requested to determine the amount of units remaining as described on, for example, pages 8-9 lines 27-9 and as well on pages 10-13 in the form of rules for accreditation.)

15. **With respect to claim 32**, Smith et al teaches the method according to claim 27, in which at least one of said accreditation rules is dependent on the life-span of requested units. (i.e. rules such as the initial "typical duration" of 4 minutes withdrawn amount on page 5 lines 11-27 relating to a "life-span" of requested units.)

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16. **With respect to claim 33**, Smith et al teaches the method according to claim 32, wherein said units are monetary units. (i.e. inherently the units are related to both time and money where units of time us used as a quantity at a given rate translating to monetary value. The terms are synonymous especially in the context of prepaid calling services where calling times are typically related in total minutes at a given value thereby conferring a monetary unit.)

17. **With respect to claim 34**, Smith et al teaches the method according to claim 32, wherein said units are units of time. (i.e. Similarly, the units are inherently related to both time and money where units of time us used as a quantity at a given rate translating to monetary value. The terms are synonymous especially in the context of prepaid calling services where calling times are typically related in total minutes at a given value thereby conferring a monetary unit.)

18. **With respect to claim 35**, Smith et al teaches the method according to claim 32, wherein said units are units of volume. (i.e. the units are inherently a unit of volume, since the total time allocated at a given prepaid price will constitute a volume of time. Similarly not the rationale in the rejection of claims 26 and 27.)

19. **With respect to claim 36**, Smith et al teaches the method according to claim 35, wherein said volume is a data volume. (i.e. may be interpreted as call data or service data collected by the Service Data Function, on page 6-7, lines 12-23, and/or any type of call as described on page 8, lines 7-11.)

20. **With respect to claim 37**, Smith et al teaches the method according to claim 32, wherein said units relate to the amount of used bandwidth. (i.e. the use of certain



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different types of call including voice and/or videoconferencing telephone calls, facsimile calls, and calls to transfer data as described on page 8 lines 7-11, create bandwidth related to the exchange of information over communication lines. Such as often the case in dial up services. Also note that page 7, lines 24-31 refer to other interfaces and networks such as a radio air interface as well as other mobile models.)

21. **With respect to claim 38**, Smith et al teaches the method according to claim 37, wherein said account can be accessed by at least one user. (i.e. the use of the term "subscriber's account" designates the use of an accessible account providing for a method of determining, in the least, the time remaining on the account. Similarly, the claim may be interpreted to mean that at least one user can access the prepaid account, such as when they make a call on the account they have accessed the account for prepaid services.)

22. **With respect to claim 39**, Smith et al teaches the method according to claim 38, which is used in a telecommunications environment, wherein at least one of the services provided relates to a group comprising voice, data and internet communications. (i.e. the use of certain different types of call including voice and/or videoconferencing telephone calls, facsimile calls, and calls to transfer data as described on page 8 lines 7-11, create bandwidth related to the exchange of information over communication lines.)

23. **With respect to claim 40**, Smith et al teaches the method as described in claim 39, wherein said telecommunications environment is accessible via a group comprising wireless and fixed connections to a telecommunications network. (i.e. Please note that

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page 7, lines 24-31 and page 8, lines 1-6 refer to other interfaces and networks such as a radio air interface as well as other mobile models. Also note that pages 12-13, lines 20-5 refer to fixed networks.)

24. **With respect to claim 41**, Smith et al teaches the method according to claim 40, wherein management or provisioning of said services is carried out by a plurality of service provisioning systems which are in communicative connection with said credit management. (i.e. service provisioning systems such as the Service Data Function, Service Control Function, Intelligent Network, Service Control Points, Service Switching Function or Mobile Station Integrated Services Digital Network Number are some examples. These are found throughout and related to the credit management or determination of allocations.)

25. **With respect to claim 42**, Smith et al teaches a multi service telecommunications system, comprising: at least one credit management system for registering or managing reservation of available units in an account comprising a predetermined amount of units, further comprising means for providing services in exchange for units, said means being further arranged for reserving units before provisioning of a service, wherein said credit management system is arranged for carrying out a forced booking of actually consumed units during service provisioning for at least one service. (This claim is rejected under a similar rationale as in claim 23, i.e. either the amount that is "force" booked such as the "short call" or it could be interpreted to be the amount that is "force" booked in subsequent allocations and with the

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appropriate structure to execute the process. As similarly described in the abstract, pg 5 lines 11-27, and pg 6-7 lines 12-4.)

26. **With respect to claim 43**, Smith et al teaches the multi service telecommunications system according to claim 42, wherein said credit management system forms at least a part of a device comprised in said telecommunication system. (i.e. the heart of the invention relates to a prepaid telecommunication system for prepaid calling that includes and is not limited to voice and/or video conferencing telephone calls, facsimile calls and calls to transfer data, etc., throughout and on page 8, lines 7-11.)

27. **With respect to claim 44**, Smith et al teaches the multi service telecommunications system according to claim 42, wherein said credit management system forms at least a part of a user device comprised in an arrangement for connecting to said telecommunications system. (i.e. service provisioning systems such as the Service Data Function, Service Control Function, Intelligent Network, Service Control Points, Service Switching Function or Mobile Station Integrated Services Digital Network Number are some examples. These credit management systems are devices that connect to the telecommunications system.)

### ***Response to Arguments***

28. Applicant's arguments filed 03/04/2009 have been fully considered but they are not persuasive. At the outset, Applicant's arguments do not comply with 37 CFR 1.111(c) because they do not clearly point out the patentable novelty which he or she thinks the claims present *in view of the state of the art disclosed by the references*

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*cited or the objections made.* Applicant merely characterizes the present invention and prior art, then further provides a conclusory statement as to an alleged lack of disclosure in the prior art. Similarly, they do not show how the amendments avoid such references or objections (i.e. claim rejections under 101 as well).

29. The features for which Applicant relies upon recited as "forced booking, during service provisioning by the credit management system, of actually consumed units for at least one service" has been addressed by the Examiner in the rejection. In short, the specification of this case attempts no definition of the claim language "forced booking." Accordingly, it is presumed that the phrase was used in its commonly accepted technical sense. *In re Barr*, 170 USPQ 330 (CCPA 1971). The claims have been interpreted as broadly as their terms reasonably allow. *See In re Pearson*, 181 USPQ 641 (CCPA 1974); *In re Zletz*, 13 USPQ2d (Fed. Cir. 1989). Therefore, it is the Examiner's position that, in the least, the broadest reasonable interpretation of "forced booking" is merely that the booking or allocation is carried out or expected to occur due to "actually consumed units." Applicant claim recitation appears to fit a model wherein units are consumed as in the case of Smith et al. and the use of the telecommunications and then there is some form of charge or forced booking the in credit management system. The forced booking of actual consumed units is merely the allocation of those credited units to a call that has finished. In effect, this process is inherent if not explicit in credit management systems since units that are consumed are always blocked, provisioned and/or removed from the credit management system. In fact, it would contradict practical business sense to assume that the consumed units aren't removed

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or force booked from the available credit units since once a consumer uses an amount of predetermined units the profitable business would seek to prevent them from reusing additional time not paid for.

Similarly, the Examiner has maintained the rejections under 35 U.S.C. 101 since the amendments have failed to render the claims statutory. For example, the body of the claim newly amended to steps of reserving and executing could be performed by a person. In particular, a person could take verbal orders and execute booking by hand through a ledger to keep credit and debit information for services rendered. As previously recited, “[t]o qualify as a statutory process, the claim should positively recite in the body of the claim, the particular machine to which it is tied. For example, by identifying the particular machine that accomplishes the method steps, or positively reciting the article that is being transformed.” Please note that the particular machine must not constitute extra-solution activities.

### ***Conclusion***

30. The Examiner has pointed out particular references contained in the prior art of record, within the body of this action for the convenience of the Applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply. Applicant, in preparing the response, should consider fully the entire reference as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the Examiner.

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31. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael M. Thompson whose telephone number is (571) 270-3605. The examiner can normally be reached on Monday thru Friday 8am-5:30 except Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (571) 272-6812. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Michael M Thompson/  
Examiner, Art Unit 3629

/JOHN G WEISS/  
Supervisory Patent Examiner, Art Unit 3629